

Appln. No. 10/762,042
Amendment dated November 23, 2005
Reply to Office Action mailed August 23, 2005

REMARKS

Reconsideration is respectfully requested.

Claims 1, 2 through 10, and 12 through 14 remain in this application. Claims 2, 11, and 15 through 18 have been cancelled. No claims have been withdrawn. Claims 19 through 22 have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 1 through 5 of the Office Action

Claims 1 through 5 and 8 through 17 have been rejected under 35 U.S.C. §102(b) as being anticipated by Vosatka.

Claims 7 and 18 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Vosatka in view of Bristol.

Claim 6 has have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Vosatka in view of DeHart.

Claim 1, particularly as amended, requires "said front panel having a slit therein, said slit forming a pair of opposed edges on said front panel" and "a closure means for selectively closing said slit in said front panel and said opening of said pouch member, said closure means being located on said opposed edges of said slit". Claim 10 requires "a closure means for selectively closing said slit in said front panel and said opening of said pouch member, said closure means being located on said opposed edges of said slit".

It is alleged in the Office Action that the Vosatka patent teaches all of the requirements of claims 1 and 10. However, it is submitted that the requirements of claims 1 and 10, particularly as amended, are not anticipated by the Vosatka patent. In particular, it is submitted that the

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Vosatka patent does not show the closure means of the invention located on the edges of any slit in the Vosatka shirt.

It is therefore submitted that the Vosatka patent would not lead one of ordinary skill in the art to the applicant's claimed invention as defined in claim 1, especially with the requirements set forth above, and therefore it is submitted that claims 1 and 10 are allowable over the prior art. Further, the claims that depend from claims 1 and 10, also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Furthermore, the rejections of claims 6 and 7 of the Office Action rely upon an allegedly obvious combination of the Vosatka patent with the Bristol and DeHart patents in an attempt to assemble the combination of elements required by these claims.

It is significant to note that the courts have recognized that most elements of inventions can be found somewhere in the prior art.

Most if not all inventions arise from a combination of old elements.
See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

And thus the ability to find each one of the claimed elements in the prior art does not in and of itself negate patentability.

Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

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The Office Action sets forth a number of reasons that are alleged to support the combinations of the various parts of the cited references. However, these reasons do not appear to be taken from the prior art, but from an ex post facto analysis of the combination of the features disclosed in the applicant's application, and possible benefits of the applicant's invention applied to the prior art parts.

In particular, there does not appear to be any suggestion in either the Vosatkas patent or the Bristor patent that the indicia (22) of Bristor would be suitable or even desirable for the button-down "eyeglass pocket shirt" of Vosatkas. Furthermore, it does not appear that the Vosatkas patent suggests in any way that the button-down "eyeglass pocket shirt" of Vosatkas might benefit from a hood or that the DeHart patent that a button-down shirt such as is shown in Vosatkas would be suitable for the hood of DeHart.

A motivation must be provided by the prior art to make the allegedly obvious combinations of parts relied upon in making an obviousness rejection.

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc. , 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998).

In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Absent a showing of motivation in the prior art to make the allegedly obvious combination, it can only be assumed that the applicant's disclosure has provided the motivation for making the combination of elements from the prior art, and not the prior art itself.

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the

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essence of hindsight. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is therefore submitted that the combination of individual parts taught by the various prior art references relied upon in the Office Action would not motivate one skilled in the art to arrive at the applicant's claimed invention.

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Vosatkas, Bristor, and DeHart set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 6 and 7.

Withdrawal of the §102(b) and §103(a) rejections of claims 1, 3 through 10, and 12 through 14.

Added Claims

Added claim 19 requires that "said closure means does not extend through said slit of said front panel". It is submitted that the Vosatkas patent would not lead one of ordinary skill in the art to this feature of the invention as required by claim 19.

Added claim 20 requires that "said opening of said pouch member is defined by opposed edge portions of the pouch member, and said closure means bridges between said opposed edges of said slit and said opposed edge portions of said pouch member". It is also submitted that the prior art, and particularly the Vosatkas patent, would lead one of ordinary skill in the art to this structural requirement of claim 20.

Added claim 21 requires that "said closure means comprises a pair of strips of complementary hook and loop fastener components, and each of said strips is positioned across a respective edge of said front panel and edge portion of said pouch member". It is submitted that this requirement is

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completely foreign to the teaching of the Vosatkas patent, which fails to show any hook and loop fastener structure, especially one configured as required by the language of claim 21.

Added claim 22 requires that "said front panel of said main portion has an interior surface, and said opening of said pouch member is defined by a pair of edge surfaces, said edge surfaces of said pouch member being abutted against said interior surface of said front panel of said main member". This required structure is also submitted to be strange in view of the teaching of Vosatkas.

Allowance of the added claims is also respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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